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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,743	12/04/2001	Jonathan James Stone	450110-03698	2606
20999	7590	11/22/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			LEMMA, SAMSON B	
		ART UNIT	PAPER NUMBER	
		2132		

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SF

Office Action Summary	Application No.	Applicant(s)	
	10/006,743	STONE, JONATHAN JAMES	
	Examiner	Art Unit	
	Samson B Lemma	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 04 December 2001.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-39 is/are pending in the application.

4a) Of the above claim(s) 29,30 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-39 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>02/27/2004</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

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DETAILED ACTION

1. Claims **1-28** and **31-39** have been examined. Claims **29 and 30** have been cancelled by the applicant.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119 (a)-(d), which papers have been placed of record in the file.

Preliminary Amendment

3. The preliminary amendment, submitted and requested for consideration by the applicant is acknowledged. The office action is written based on the submitted amended claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

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5. **Claims 1,11,12,13, 27 and 28** are rejected under 35 U.S.C. 102(e) as being anticipated by Chung et al (hereinafter referred as Chung)(U.S. Patent 6,310,962)

6. **As per claims 1, 11 ,27 and 28** Chung discloses a material processing system/computer program for processing material including a watermark, the system comprising (the “material” is met by the applicant as e.g. video, audio or data on the submitted abstract on the first sentence and on the submitted diagram, figure 1, ref. Num “632”. The office has interpreted the “material” in light of the disclosure)

- A remover for removing the watermark, (figure 6, ref. Num “224”;figure 7, ref. Num “270” ; Column 8, lines 65-Column 9, line 3; column 9, lines 45-50)
- A processor for processing the material from which the watermark has been removed,(figure 6, ref. Num “ 224”; Column 8, lines 65-column 9, line 3) (The “processor” is defined by the applicant as editor a special effect machine, a mixer or any other video processor as explained on the submitted disclosure page 3, lines 5-7. The office has interpreted the processor as the “adaptive estimator” for video processing which is used for preventing the error during the motion estimation by first removing the digital watermark information and process the encoded data without the watermark information as explained on column 8, lines 65- column 9 line 3 and shown on figure 6, ref. Num “230”)
- An inserter for inserting a watermark into the processed material. (Figure 6, ref. Num “240”; figure 7, ref. Num “272”; column 8, lines 35- 59) (The digital data which the watermark has been removed from by the

digital watermark remover is processed by the adaptive estimator and then the digital watermark is inserted again on the processed encoded data as shown on figure 6, ref. Num "240". Figure 7, ref. Num "272" also shows how the digital watermark is re-inserted once it has been removed.)

7. **As per claims 12 and 13 Chung** discloses the method as applied to claim 11 and 12 above. Furthermore Chung discloses the method wherein the steps of removing and inserting are automatic and independent of a user of the processor and are also hidden from the user. (figure 6, ref. Num "240" and ref. Num "242"; figure 7, ref. Num "270" and ref. Num "272"; column 9, lines 37)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 2 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over, Chung et al (hereinafter referred as Chung)(U.S. Patent 6,310,962) in view of Nakano, Hirotaka. (hereinafter referred to as Nakano) (European patent application publication). (EP 0859503 A2)

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10. **As per claim 2,** Chung discloses that the digital watermark inserter as shown on figure 6, ref. Num "240" makes digital watermark information not removable by a user except an author or authorized user.(column 8, lines 11-12).

Chung does not explicitly disclose the processor has a user interface for controlling the processes performed thereby.

However, in the same field of endeavor, **Nakano** discloses authorized users accessing the watermark information produced by the processor by interfacing with data communication controller as shown on figure 6, ref. Num "604". (Column 6, line 50-column 7, line 24)

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to combine the features of proving authorized user interface for accessing the watermark produced by the processor through the controller as per teachings of Nakano in to the method taught by Chung, in order to provide authorized user to directly access the corresponding watermark information.

11. **As per claims 3,** the combinations of chung and Nakano discloses the system as applied to claims 2 and above. Furthermore Chung discloses the system wherein the remover and the inserter are arranged to operate automatically and independently of the user. (figure 6, ref. Num "240" and ref. Num "242"; figure 7, ref. Num "270" and ref. Num "272"; column 9, lines 37)

12. **Claims 4 -10 and 14-26 and 31-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over, Chung et al (hereinafter referred as Chung)(U.S. Patent 6,310,962) in view of "Linnartz". (hereinafter referred to as Linnartz) (U.S. Patent No. 6,314,518)

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13. **As per claims 21-24 Chung** discloses

- A method of removing data embedded in material (figure 6, ref. Num "242" and figure 7, ref. Num "270"; Column 8, lines 65-Column 9, line 3; column 9, lines 45-50) (the "data embedded in material" is met by the applicant and the office as the "watermark" as explained on the submitted disclosure on pages 1 and 2) comprising the steps of:
 - Receiving material in which data is embedded; (figure 6, ref. Num "242", figure 7, ref. Num "272") (the digital data with the watermark embedded in it is received at the digital watermark remover as shown on figure 6, ref. Num "242" and figure 7, ref. Num "242" from the "dequantizer" as shown on figure 6 and 7 respectively.)

Furthermore Nakano discloses how the watermark is intentionally removed at the digital watermark remover. (Figure 6, ref. Num "242" and figure 7, ref. Num "270")

Chung does not explicitly disclose accessing an information store storing information enabling the data to be removed; and removing the said data using the enabling data accessed from the store. (The "enabling data" is defined by the applicant as "encryption /decryption key" as explained on page 1, line 24, the same interpretation is used by the office).

However, in the same field of endeavor, **Linnartz** discloses a detector as shown on figure 6, ref. Num "69" able to detect or retrieve or remove the watermark information from the digital data and send it back to the controller in the drive as shown on figure 6, ref. NUM "52" after the digital data is decrypted by retrieving the key which is shown on figure 6, ref. Num "65" at the decryption unit or key storage unit as shown on figure 6, ref. Num "66". The drive as shown on figure 6, ref. Num "52" first encrypt the digital data which has a watermark information in it with the encryption key shown on figure 6, ref. Num "62" stored at the unit shown on figure 6, ref. Num "61" and sent the

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encrypted digital data through a secure path shown on figure 6, ref. Num "63". The decoder has a storage unit as shown on figure 6, ref. Num "66" which stores the decryption key as shown on figure 6, ref. Num "65". The detector shown on figure 6, ref. Num "69" using this key accessed from the storage unit, retrieves or removes the watermark information and encrypt this watermark information at the encryption unit as shown on figure 6, ref. Num "67" and send to the controller shown on figure 6, ref. Num "53", via secure path shown on the figure 6, ref. Num "64". The controller controllers the processing of the material based on this watermark information.

(Column 8, lines 31-56)

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to combine the features of accessing the enabling data or encryption/decryption key from the key store to retrieve or detect or removes the watermark information which is embedded in the digital data as per teachings of Linnartz in to the method taught by Chung, in order to securely remove the watermark and communicate the watermark to controller so that the watermark information is not damaged during processing and prevent illegally accessing or changing of the watermark information by unauthorized users.

14. **As per claims 4 and 14, Chung** discloses a method of removing data embedded in material (figure 6, ref. Num "242" and figure 7, ref. Num "270"; Column 8, lines 65-Column 9, line 3; column 9, lines 45-50) (the "data embedded in material" is met by the applicant and the office as the "watermark" as explained on the submitted disclosure on pages 1 and 2). **Chung** does not explicitly disclose a system according to claim 1, and 11 further comprising a database processor linked to the remover, the database processor containing data enabling the removal of the watermark from the material to be processed.

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However, in the same field of endeavor, **Linnartz** discloses a detector as shown on figure 6, ref. Num "69" able to detect or retrieve or remove the watermark information at the decoder and send it back to the controller in the drive as shown on figure 6, ref. NUM "52" after the digital data is decrypted by retrieving the key which is shown on figure 6, ref. Num "65" which is stored at the decryption unit or key storage interpreted by the office to be the database for storing the enabling data or the key unit as shown on figure 6, ref. Num "66".) (Column 8, lines 31-56)

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to combine the features of accessing the enabling data or encryption/decryption key from the key store or database to access or retrieve or the watermark information which is embedded in the digital data as per teachings of Linnartz in to the method taught by Chung, in order to securely remove the watermark and communicate the watermark to controller so that the watermark information is not damaged during processing and prevent illegally accessing or changing of the watermark information by unauthorized users.

15. **As per claims 5 and 15, Chung** discloses the method of removing watermark information and later inserting the watermark information as shown on figure 6, ref. Num "242" and ref. Num "240" or figure 7, ref. Num "270" and ref. Num "272").

Chung does not explicitly disclose a database processor linked to the inserter, the database processor containing data enabling insertion of the watermark into the processed material. (The "enabling data" is defined by the applicant as "encryption /decryption key" as explained on page 1, line 24, the same interpretation is used by the office).

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However, in the same field of endeavor, **Linnartz** discloses a decoder and a drive which are communicating the watermark information through a secure link by using encryption/decryption key as shown on figure 6, ref. Num "62" and ref. Num "65" which is stored in the encryption/decryption unit as shown on figure 6, ref. Num "61" and ref. Num "66" respectively which is interpreted by the office as the database for storing keys.(figure 6; column 8, lines 31-56)

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to combine the features of accessing and transmitting watermark information using encryption/decryption key from the key store or database to access or retrieve the watermark information as per teachings of Linnartz in to the method taught by Chung, in order to securely insert the watermark and prevent illegally accessing or changing of the watermark information by unauthorized users.

16. **As per claims 9 and 19, Chung** discloses two ways of preventing illegal copying one method is using encryption and the other method is using watermark method. The watermark is embedding or inserting to prevent illegal copying. (Column 1, lines 43-62). Furthermore Chung discloses that the watermark is used on the original image and is invisible to unauthorized users but the author can prove that the copied image is his by virtue of an arbitrary reverse processing. (Column 1, lines 59-62)

Chung does not explicitly disclose the system arranged to check the authenticity of the said material including the reversible watermark.

However, in the same field of endeavor, **Linnartz** discloses using the drives hashes and adds random number and signs the MPEG stream using the well known cryptographic algorithms like RSA or DSA. The MPEG decoder then verifies the signature and detects the watermark and sends the message back to the drive. (Column 8, lines 65-column 9, line 1).

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It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to combine the features of checking the authenticity of the communicating parities transferring and receiving digital data using hashes and digital signature as per teachings of Linnartz in to the method taught by Chung, in order to authenticate the digital data or the material on which the watermark is embedded.

17. **As per claims 6, 16, 31 and 34**, the combination of Chung and Linnartz discloses the methods as applied to claims 4, 14, 5 and 15 above. Furthermore Linnartz discloses the system/ method/ apparatus further wherein the said enabling data includes an encryption key. (figure 6, ref. Num "62"; column 8, lines 31-56)
18. **As per claims 7, 17, 32, and 35**, the combination of Chung and Linnartz discloses the methods as applied to claims 4, 14, 5 and 15 above. Furthermore Linnartz discloses the system/ method/ apparatus wherein the inserter and the remover are linked to the database processor by a communications link.(figure 6, ref. Num "64")
19. **As per claims 8, 18, 36**, the combination of Chung and Linnartz discloses the methods as applied to claims 7, 17 and 35 above. Furthermore Linnartz discloses the system/ method/ apparatus wherein the communications link includes the internet.
(Column 9, lines 53-58)
20. **As per 33**, the combination of Chung and Linnartz discloses the methods as applied to claims 8 above. Furthermore Linnartz discloses the system/ method/ apparatus wherein the inserter and the remover are linked to the database processor by a communications link. (figure 6, ref. Num "64")
21. **As per claims 10 and 20**, the combination of Chung and Linnartz discloses the methods as applied to claims 9 and 19 above. Furthermore Linnartz discloses the

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system/ method/ apparatus wherein arranged to disable the said processor if the material fails the authenticity check. (Column 8, lines 57-67)

22. **As per claim 25,** the combination of Chung and Linnartz discloses the methods as applied to claims 23 above. Furthermore Linnartz discloses an apparatus wherein a generator for generating the enabling information. (Figure 6, ref. Num "61", figure 6, ref. Num "66" and figure 6, ref. Num "67" and "60") (The "enabling data" is defined by the applicant as "encryption /decryption key" as explained on page 1, line 24, the same interpretation is used by the office. These keys are generated/available and stored wherever the encryption and decryption is performed as explained on column 8, lines 31-57).

23. **As per claims 26, 37-39,** the combination of Chung and Linnartz discloses the methods as applied to claims 24,21,22 above. Furthermore Chung discloses an apparatus wherein the material is one or more of video material, audio material and data material. (Figure 1, ref "Video Input")

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samson B Lemma whose telephone number is 571-272-3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BARRON JR GILBERTO can be reached on. The fax phone number for the organization where this application or proceeding is assigned is 571-272-3799.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.L.

SAMSON LEMMA

11/8/2004



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